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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,442	02/01/2002	Nicholas Charles Parson	57380-Z CCD	3501

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EXAMINER
IP, SIKYIN

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/066,442	PARSON ET AL.	
	Examiner	Art Unit	
	Sikyin Ip	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/16/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/16/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-24 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 61030684 in view of USP 3879194 to Morris et al.

The JP 61030684 reference in the abstract discloses the features substantially as claimed. The disclosed features include providing an Al or Al alloy, extruding the Al base alloy aging the extruded Al base alloy with T5 process, etching the extruded Al base alloy in NaOH, anodizing the etched Al base alloy to provide a gray matte finish. The difference between the reference(s) and the claims are as follows: The JP 61030684 in the abstract discloses the Al base alloy series number which does not exact match the Al base alloy as claimed. However, Morris et al in the abstract disclose the composition of 6063 Al base alloy in the same field of endeavor or the analogous

metallurgical art. Therefore, the claimed invention has been taught by the cited references.

Cast molten metal into a plurality of billets for workability of the billets is contemplated within ambit of ordinary skill artisan. With respect to the population of billets as set forth in instant claims 17-24 that it is well settled that merely changing the size (here population) of an article is not a matter of invention. In re Rose, 105 USPQ 237 (CCPA 1955) and In re Yount, 36 CCPA (Patents) 775, 171 F.2d 317, 80 USPQ 141.

Claims 9-24 are rejected under 35 U.S.C. 103(a) as obvious over GB 1484595 (PTO-1449).

GB 1484595 discloses the features including the claimed Al based alloy composition and steps of extruding, aging, etching, and anodizing (page 4, lines 8-14 and pages 4-5, example 1). When prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the

subject matter disclosed by the reference. Furthermore, overlapping ranges have been held to be a prima facie case of obviousness. See In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

Cast molten metal into a plurality of billets for workability of the billets is contemplated within ambit of ordinary skill artisan. It is contemplated within ambit of ordinary skill artisan to use recycled scrap with virgin metal to form molten metal for economical reason. Moreover, it is a routine practice to monitor and adjust the chemistry of a molten metal before casting.

With respect to the population of billets as set forth in instant claims 17-24 that it is well settled that merely changing the size (here population) of an article is not a matter of invention. In re Rose, 105 USPQ 237 (CCPA 1955) and In re Yount, 36 CCPA (Patents) 775, 171 F.2d 317, 80 USPQ 141.

Terminal Disclaimer

The terminal disclaimer filed on April 9, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USP 6375767 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Applicant's declaration and arguments filed March 16, 2006 have been fully considered but they are not persuasive.

Declaration filed on March 16, 2006 is noted. But, controlling casting impurities is contemplated within ambit of ordinary skill artisan. Difference in degree of purity itself does not predicate patentability. In re King, 43 USPQ 400 and In re Merz, 38 USPQ 143 and In re Cofer, 354 F2d 664, 148 USPQ 268 (CCPA 1966). Figure 3 in the instant declaration fails to show unexpected result of criticality because the difference of gloss units due to Cu content is less than 10%.

Applicants' statement of commercial success in instant declaration is noted. But there is no basis or comparison for the claimed commercial success.

Applicants' argument with respect to recited Cu content is noted. But, first, the instant claims do not possess that same limitations as allowed product claims which have narrower elements ranges (see instant claim1). Moreover, instant 132 declaration failed to show claimed Cu content is critical and possessed unexpected result. It is known in the art of cited references that less impurities would produce better properties.

Applicants argue that cited references fail to disclose the claimed Cu contents. But, the instant claimed Cu contents are overlapped by the Cu contents of cited references (Morris, col. 1, lines 10-16; GB 1484595, page 4, lines 8-13). Furthermore, difference in degree of purity itself does not predicate patentability. In re King, 43 USPQ 400 and In re Merz, 38 USPQ 143. Changing form, purity, or other characteristic of an old product does not render the novel form patentable where the difference in form, purity or characteristic was inherent in or rendered obvious by the prior art. In re Cofer, 354 F2d 664, 148 USPQ 268 (CCPA 1966).

Applicants' argument with respect to the combination of JP 61030684 and Morris is noted. But, Morris is merely cited to show the composition of conventional 6063 series Al alloy. Moreover, JP 61030684 does not disclose Cu in their alloy and Morris

discloses Cu content including zero (abstract) which have evinced that alloys of JP 61030684 and Morris do not require Cu as claimed.

Conclusion

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been meet by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
May 29, 2006